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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,769	03/01/2002	Joseph M. Kochansky	074339.0005 BLAC-106	8954

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EXAMINER	
PATEL, JAGDISH	

ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
12/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/086,769	KOCHANSKY, JOSEPH M.	
	Examiner	Art Unit	
	JAGDISH PATEL	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *28-36* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response the applicant's filing 9/14/07.

Response to Amendment

2. Claims 1-2, 10-11 and 19 have been amended. Claims 28-36 have been withdrawn from further consideration. Amended claims 1-27 have been examined.

Response to Arguments

3. Applicant's arguments with respect to amended claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

4. Newly amended claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a method of determining whether a transaction involving a financial instrument is compliance with investment objectives associated with an investment portfolio. The claim recites step d) referring to "at least one rule" in order to determine compliance of the investment request. However, both steps b) and c) refer to different version of the at least one rule. Step b) applies at least one rule provided in step a) (the at least rule includes a reference to a dynamic database) to the investment request. Step c) by incorporating each of the related

entries contained in the dynamic database into the at least one rule inherently creates a new version of the rule because it affects the at least one rule referenced in steps a) and b). The claim therefore is ambiguous as to (i) the relationship of steps c) and d) and (ii) the role of incorporating each of the plurality of entries into the rule. Does step c) update (or create a new or modified rule?) from the rule provided in step a)? If so is this version of the rule applied to the investment request?

The examiner has interpreted the claim to read applying the at least one rule as per step b). Note that when the at least on rule is applied to the investment request the most logical step that follows is step d) which is determination of the compliance of the investment request with the applied rule.

Dependent claims 2-9 also contain the aforementioned deficiency.

Note that all independent claims recite this or similar limitation and therefore are rendered indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cwenar (US Pat. 5893079) and further in view of ARNOLD (WO 00/75821 A2) (Arnold).

Per claim 1 Cwenar discloses a method of determining whether a transaction involving a

financial instrument is in compliance with investment objectives associated with an investment portfolio, (compliance capabilities, and abstract); the method comprising the steps of:

a) providing at least one rule pertaining to an investment objective, the at least one rule including a reference to a dynamic database, the dynamic database containing a plurality of entries related to the at least one rule;

(investment compliance rules are stored in a central database 4 (Fig. 1), also see exemplary Figure 4, central database 101)

b) applying the at least one rule to an investment request regarding a transaction involving a financial instrument;

(see at least col. 11 L 35-48)

d) determining whether the investment request complies with the at least one rule. (see at least col. 11 L 49 - col. 12 L 3).

e) communicating to a user via an output device whether the investment request complies with the at least one rule

(SEE Fig. 5 and col. 12 L 21-47 "audit trail report" and other

output regarding compliance).

Cwenar fails to teach, incorporating each of the related entries contained in the dynamic database into the at least one rule. Arnold, however, teaches a method of keeping investment rules current by providing a dynamic database containing a plurality of entries related to the at least one rule and incorporating each of the related entries in the dynamic database into the at least one rule (Arnold, p. 11 L 9-17, tax advantage database 38 contains a plurality of entries related to at least one (tax) rule, see description of tax advantage sub-system TAS 36, and each of the entries in the database 38 are incorporated in the tax rules).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporating each of the related entries contained in the dynamic database into the at least one rule because this would maintain the (investment or tax or compliance) rules most up to date.

Claim 2. A method according to claim 1, wherein the step of incorporating each of the related entries into at least one rule database includes referring to a dynamic list stored within the dynamic database.

(Arnold, p. 11 L 9-17 referring to claim 1 analysis wherein Arnold teaches the updating and maintaining the database 38 current, this would require incorporating each of the tax entries into the rule database)

Claim 3. A method according to claim 1, further comprising the step of storing the at least one rule is a rules database.

(see at least col. 11 L 44-48)

Claim 4. A method according to claim 1, further comprising the step of receiving the investment request from an interested party.

(see at least col. 11 L 35-39)

Claim 5. A method according to claim 1, further comprising the step of reporting, to an interested party, whether the investment request complies with the at least one rule.

(see at least col. 11 L 58 - col. 12 L 6)

Claim 6. A method according to claim 1, wherein the step of applying the at least one rule to an investment request is executed by an interested party.

(see at least col. 11 L 35-42, rules are invoked when a trade is executed by a user..)

Claim 7. A method according to claim 1, wherein the step of applying the at least one rule to an investment request is self-executing.

(see at least col. 11 L 39-42, the server executes compliance rules without the user)

Claim 8. A method according to claim 1, further comprising the step of modifying the dynamic database.

(see at least Col. 11 L 44-48 inputting rules through external user interface)

Claim 9. A method according to claim 2, further comprising the step of providing at least one dynamic entry in a dynamic list stored within the dynamic database.

(see at least Col. 11 L 44-48 inputting rules through external user interface)

Claim 10. A method of determining whether an investment portfolio is in compliance with investment objectives, the method comprising the steps of: a) providing at least one rule pertaining to an investment objective, the at least one rule including a reference to a dynamic database, the dynamic database containing a plurality of related entries; b) applying the at least one rule to the investment portfolio; c) referring to the dynamic database to incorporate each entry contained therein into the at least one rule; and d) determining whether the investment portfolio complies with the at least one rule.

(refer to claim 1 analysis. It is asserted that Cwenar also applies to an investment portfolio as detailed for example at col. 11 L 49- 58, the structure of the compliance process for a trade transaction is also applicable to the individual portfolio such as a (portfolio of stocks or other securities in a mutual fund).

Claims 11-12: refer to claims 2 and 3 analysis.

Claim 13. A method according to claim 10, further comprising the step of receiving financial data relating to financial instruments contained in the investment portfolio.

(Refer to data sources 10, 12, 14, and 16 in Figure 1, see relevant discussion at col. 4 L 51- col. 5 L 21).

Claims 14-18 : refer to claims 5-9 analysis.

System claims 19-27 are interpreted according to their respective method claims and accordingly rejected under 35 U.S.C. 102(b) as being anticipated by Cwenar as explained.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu!

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KRAMER JAMES A can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jagdish N. Patel
(Primary Examiner, AU 3693)
12/16/07

Notice of References Cited	Application/Control No. 10/086,769	Applicant(s)/Patent Under Reexamination KOCHANSKY, JOSEPH M.	
	Examiner JAGDISH PATEL	Art Unit 3693	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2002/0038273	03-2002	Wherry et al.	705/36
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	wo 00/75821A2	12-2000	CA	ARNOLD	G06F 17/60
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.